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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,613	08/16/2001	Ernst-Michael Hamann	DE920000049US1	3019

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EXAMINER
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LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/931,613	HAMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Etienne P LeRoux	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

*Claim Status:*

Claims 1-7 and 10-18 are pending. Claims 8 and 9 have been cancelled. Claims 1-7 and 10-18 are rejected as detailed below.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 and 10-18 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,220,510 issued to Everett et al (hereafter Everett), as best examiner is able to ascertain.

Claims 1 and 10-18 :

Everett discloses embedding one or more static objects in one or more defined storage areas [Fig 1, 103] in the dynamic file system [Fig 1, 107] and excluding said data objects from actions performed dynamically on the file system that would cause said data objects to occupy storage outside of said defined storage areas [col 6, lines 15-20, col 8, lines 5-20, Fig 6, col 11, line 59 through col 12, line 30].

Claim 2:

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Everett discloses defining an embedded static object by a memory address and a fixed size [Figs 1 and 6]

Claim 3:

Everett discloses creating an embedded static data object by specifying a predetermined storage size, scanning memory for an available storage area large enough in size for receiving the static data object and allocating the storage area for the static object [Figs 1 and 6]

Claim 4:

Everett discloses creating an embedded object by specifying a storage area having a predetermined memory address and a predetermined storage size, allocating the storage area if it is not being used, and if the area is already in use, moving data using the area to a different memory location and allocating the area thereafter [Figs 1 and 6]

Claim 5:

Everett discloses managing a file system on a chipcard [col 2, lines 20-25]

Claim 6:

Everett discloses accessing a static object in a preboot phase of a host system connected to the chipcard [col 7, lines 30-35]

Claim 7:

Everett discloses storing security-relevant data in a static object [col 7, lines 30-35]

***Response to Arguments***

Applicant's arguments filed 2/22/2006 have been carefully considered but are not persuasive for the reasons given below.

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**Application Argues:**

Applicant states in the first paragraph of page 8:

In the first place, Everett's dynamic data space 107 is not a "file system" as claimed by applicants. As applicants have noted previously, the online encyclopedia defines a "file system" as "[t]he system that an operating system or program uses to organize and keep track of files." Similarly, the online encyclopedia Wikipedia defines a files system as "a method for storing and organizing computer files and the data they contain to make it easy to find and access them." A "file system" is thus a programming construct and not simply anything (hardware, software or whatever) that may contain a file. It certainly does not include Everett's dynamic data space 107, which is more properly characterized as a segment of a virtual address space (col 4, lines 24-31). Indeed, the only time the term "file" even appears in the specification is in the variable name `selected_file_application_id` in steps 301 and 301 in Fig. 3 and steps 407 and 411 in Fig. 4.

**Examiner Responds:**

Examiner is not persuaded. MPEP § 2106 requires Office personnel to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed cir 2003) (claims must be interpreted in view of the specification without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551(CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322(Fed. Cir. 1989) (During patent examination the pending claims must be interpreted as broadly as their terms reasonable

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allow .... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed .... An essential purpose of patent examination is to fashion claims that are precise, clear, correct and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.

Examiner notes the MPEP requires Office personnel to interpret claims in view of the specification without importing limitations from the specification into the claims unnecessarily. Applicant fails to point to the specification of instant application for any disclosure to what might comprise a "file system." Certainly, The MPEP does not require an examiner to interpret the claimed "file system" according to Wikipedia, Webopedia or any other online or off-line dictionary and/or encyclopedia.

Considering claim 1 in further detail. Examiner notes that "data objects" are claimed three times, and storage areas are claimed twice while a "file system" is claimed twice. Therefore, the sum of the data objects and storage areas is five(5) which is far in excess of two(2) for the claimed "file system" therefore, examiner maintains that the present invention concerns static objects in memory. In fact this is substantiated by the title of instant invention which reads "Ensured Access to Static Objects inside a Dynamic Token Memory." Examiner notes once again that "file system" is not even included in the title.

Furthermore, examiner notes that the present invention as claimed in the preamble concerns a "dynamic file system" as opposed to the "file system" which Applicant considers above. Examiner is confused because the difference, if any, between a "file system" and a "dynamic file system" is not immediately apparent. For purposes of this discussion, Examiner

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will consider a “dynamic file system” per the claimed invention and thus Applicant’s comments as above will not be considered for patentability purposes.

Turning now to Applicant’s disclosure, paragraph 14 as this is the closest that examiner could find that even comes close to defining the claimed “dynamic file system.”

Summary of Invention Paragraph:

[0014] According to the present invention, static data objects are managed in a dynamic file system. A kind of embedment takes place in which one or more static objects are embedded in the dynamic file system within a file. The static objects are excluded from management actions performed on the dynamic file system.

A skilled artisan would be puzzled by the lack of technical rigor in above description by applicant. Making and using the invention is not advanced by language such as “kind of embedment.” Additionally, what can be concluded from above disclosure by Applicant is that static objects in a “dynamic file system” (exact definition is unknown because it is not provided by applicant) are excluded from management actions. Again management actions are not defined. It is unclear whether management actions are preformed by human beings or by some other computer process. At best, in the final analysis, what can be said is that static objects are somehow or another excluded from actions. Based on this conclusion, examiner maintains the following disclosure by Everett reads on “static objects which are excluded from actions.”

Everett discloses the following in column 5, lines 8-20:

Pointers to other specific regions of the Static data area can be stored in the Static data because the Static region is non-volatile. For example, if the card user's name is stored in the Static memory of a credit/debit application, the application will know the card user's name will always

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be stored in the 5.sup.th memory location above the starting point for the Static portion of memory. The location can be noted as SB[5] or the 5.sup.th byte above the Static Bottom. Since the Static memory is non-volatile, it will not be erased after each transaction and the application will always know of its location relative to the Static segments' address registers.

**Applicant Argues:**

Applicant states in the second paragraph of page 8, the following:

Even assuming, for the sake of argument, that Everett's dynamic space 107 constitutes a "file system," the static data space 103 is not "embedded" in that structure as claimed by applicants. As defined by applicants in the specification, the term "embedding" here means either that the static data object is surrounded on both sides by the dynamic system or that the static object lies entirely within the dynamic file system and is coterminous with one end thereof (page 3, lines 27-29). Everett's static data space 103 is neither of these things. Not only is it not embedded in the dynamic data space 107, but it is not even contiguous to it, being separated from the dynamic space by the public data space 105. Even if dynamic data space 107 were contiguous to the static data space 103, as the public data space 105 appears to be Fig. 2. the static data space would not be embedded in it, since they would still be disjoint. They would of necessity always be disjoint, since the static data space 103 corresponds to a non-volatile memory area, while the public data space 105 and the dynamic data space 107 map to volatile memory areas.

**Examiner Responds:**

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant



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relies (i.e., coterminous, contiguous)<sup>1</sup> are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, as noted above in paragraph 14 of the specification of instant application, “a kind of embedment” takes place. Examiner is puzzled by applicant’s explanation of “kind of embedment” in language such as coterminous, contiguous and disjoint. Examiner will not give patentable weight to above explanation by applicant.

Furthermore, examiner consulted the Microsoft Computer Dictionary and found the following definitions of embed or embedded:

embed: To insert information created in one program, such as a chart or an equation, into another program. After the object is embedded, the information becomes part of the document. Any changes made to the object are reflected in the document.

embedded: In software, pertaining to code or a command that is built into its carrier. For example, application programs insert embedded printing commands into a document to control pointing and formatting. Low-level assembly language is embedded into higher-level languages, such as C, to provide more capabilities or better efficiency.

Examiner notes that above definitions in the Microsoft computer Dictionary do not in any way substantiate the claim language “embedding one or more static data objects in one or more defined storage areas (emphasis added) in the dynamic file system.”

Given, the ambiguousness of the claim language, the lack of support in the specification and applicants interpretation of the claim language which does not agree with the specification,

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<sup>1</sup> Examiner notes that coterminous and contiguous do not appear in the specification of instant application.

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examiner maintains the following disclosure by Everett reads on the claim language “embedding one or more static data objects in one or more defined storage areas in the dynamic file system, column 5, lines 8-20:

Pointers to other specific regions of the Static data area can be stored in the Static data because the Static region is non-volatile. For example, if the card user's name is stored in the Static memory of a credit/debit application, the application will know the card user's name will always be stored in the 5.sup.th memory location above the starting point for the Static portion of memory. The location can be noted as SB[5] or the 5.sup.th byte above the Static Bottom. Since the Static memory is non-volatile, it will not be erased after each transaction and the application will always know of its location relative to the Static segments' address registers.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

*Contact Information*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

3/9/2006

A handwritten signature in black ink, appearing to read 'Etienne LeRoux', is written over the printed name and date.